

REMARKS

As a result of the April 28, 2004 Office Action, claims 14-29 stand rejected. Claims 1-13 and 30-36 were withdrawn from consideration due to a restriction requirement in a previous office action, and applicants have requested cancellation of these claims by way of the present amendment. Following entry of the amendment, claims 1-13 and 29-36 will have been cancelled; claims 21-28 will have been amended; and 37-44 will have been added.

Claims 14-29 have been rejected as follows: Claims 21-29 have been rejected under 35 U.S.C. § 101; claim 29 has been rejected under 35 U.S.C. § 112, second paragraph; claims 14-29 have been rejected under 35 U.S.C. § 103(a) under various combinations of the references Basani (U.S. Patent No. 6,718,361), Vange (U.S. Patent Application 2002/0002611) and Dievendorff (U.S. Patent No. 6,425,017). Additionally, various objections to the specification and drawings have been raised.

Applicants note that, while the claims were not amended in response to the prior office action, the patent office has provided entirely new grounds for rejection. Applicants note that a “clear issue” should develop between the Examiner and the applicants. MPEP 706.07. Nonetheless, applicants respond to the new grounds for rejection as follows:

The Section 101 Rejection

Claims 21-28 have been amended, and claim 29 has been cancelled. Applicants note that the amendments to claims 21-28 have been made to more particularly point out the invention, and that neither the amendment to claims 21-28, nor the cancellation of claim 29, is made for a reason related to patentability. However, in view of the amendments and cancellation, applicants submit that the section 101 rejection of these claims is now moot.

The Section 112 Rejection

Claim 29 has been cancelled, and thus the rejection of claim 29 is now moot. It should be noted that claim 29 has been cancelled without prejudice or disclaimer of the subject matter thereof, and not for any reason related to patentability.

The Section 103 Rejections

Independent claim 14 recites a “fulfillment server” having, among other things, “a first database which stores information relating to [a] content item.” The Examiner has rejected this claim under section 103(a) as being obvious over Basani in view of Vange, and, in particular, has found that the above-quoted feature corresponds to Basani’s “database 22” as described at col. 9, ll. 45-54 of Basani. However, the cited teaching from Basani differs from the quoted feature of claim 14.

In particular, the Examiner reads the claimed fulfillment server onto Basani’s “distribution server 16,” which is shown in Figure 1 of Basani. Figure 1 also shows database 22 as being a separate structure from distribution server 16. By contrast, in the system recited in claim 14, the database is part of the fulfillment server, as signaled in this case by the word “having” – i.e., “a fulfillment *having* ... a first database ...” (emphasis added). Thus, the teachings of Basani, as applied by the Examiner do not meet the structure recited in claim 14. It should be noted that the Office Action does not suggest that Basani could be modified to yield the claimed structure, but instead relies on Basani as teaching the claimed relationship between the fulfillment server and the first database. Since the above-described difference between claim 14 and Basani has been overlooked, applicants respectfully submit that the rejection of claim 14 should be reconsidered and withdrawn.

Claim 21 has been amended, and thus section 103(a) rejection of claim 21 has been rendered moot. However, it should be noted that, as to the prior version of claim 21, the Examiner found that the “fulfillment server” corresponds Basani’s “distribution server 16,” and that the attribute corresponded to information stored in “database 22” (see Office Action, p. 10.) Claim 21, as amended, recites that the attribute is stored at the fulfillment server. As discussed above, Basani’s database 22 is a separate component from distribution server 16, and thus claim 21, as amended, differs from this structure in Basani. Thus, applicant respectfully submits that claim 21 is patentable and should be allowed. Inasmuch as claim 37 also recites the feature that the attribute is stored at the fulfillment server, claim 37 should be allowed as well.

Since independent claims 14, 21, and 37 have been shown to be patentable over the prior art, and since claims 15-20, 22-28, and 37-44 are each dependent, either directly or indirectly, on one of these claims, the dependent claims likewise define over the prior art and are patentable at least by reason of their dependency.

Objections to the Specification

The specification has been amended to: (1) reduce the size of the Abstract to less than 150 words; and (2) to remove material on pages 49-56 that the Examiner has identified as a “computer program,” the contents of which is being re-submitted on a CD.

Regarding the amendment to the Abstract, words have been deleted from the original abstract solely to reduced the size of the abstract below 150 words, as required. The amendment to the abstract should not be construed as reflecting a change in the scope of any invention claimed, or as a change in the scope of the disclosure.

Regarding the material on pages 49-56, Applicants do not acquiesce in the Examiner’s conclusion that this material constitutes a “computer program” within the meaning of the regulations, but, in the interest of expediting prosecution of this case, have moved this material to a CD per the Examiner’s request.

Additionally, the Examiner has objected to certain material contained on pages 13, 14, 28, and 57 on the ground that this material constitutes a hyperlink and/or other form of browser-executable code. Applicant notes that the links identified by the Examiner are part of the written description, in accordance with 35 U.S.C. § 112, of the various inventions disclosed. Thus, in accordance with MPEP 608.01, the use of this material should not be objectionable. When this material is posted on the Patent and Trademark Office’s web site, applicants have no objection to the disabling of any hyperlinks contained in the specification. On this basis, applicants request that the objection to the use of hyperlinks be withdrawn.

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Draftsperson's Objection to the Drawings

Replacement drawing sheets have been provided as indicated above. The replacement drawing sheets address the draftsperson's objections, and do not add new matter.


New claims 37-44

New claims 37-44 have been added. These claims are similar in subject matter to original claims 22-29, and thus do not add new matter. While claims 37-44 are similar to claims 22-29, note that each claim in the present application speaks for itself, and applicants' comments should not be interpreted to imply that the features of claims 22-29 should be read into claims 37-44, or vice versa.

Conclusion

All grounds for rejection and objection have been addressed. Applicants thus respectfully submit that this case is in condition for allowance, and request that a Notice of Allowance be issued in the next Office Action.

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